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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,705	12/10/2001	Valdemar Portney	L-1609	4429
7590	01/12/2006		EXAMINER MILLER, CHERYL L	
Howard R. Lambert 5245 Gatewood Lane Anaheim, CA 92807			ART UNIT 3738	PAPER NUMBER
DATE MAILED: 01/12/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

17 Oct 2005

<b>Office Action Summary</b>	Application No. 10/016,705	Applicant(s) PORTNEY, VALDEMAR	
	Examiner Cheryl Miller	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.  
 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 10-12, 16-19 and 28-41 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 1-5, 10-12, 16-19 and 36-41 is/are allowed.  
 6) ☒ Claim(s) 28-33 and 35 is/are rejected.  
 7) ☒ Claim(s) 34 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17, 2005 has been entered.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-5, 10-12, 16-19, and 28-36 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28-31, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Sarfarazi (US 6,423,094 B1, cited in IDS). See figure 17B. Referring to claim 28, Sarfarazi discloses an IOL (fig.17B) comprising a lens (126) having an elastically deformable curved surface (made of a soft material and disclosed to be deformable, fig.3-5; col.4, lines 56-60), a static haptic (132B) having a flexible portion (connection of 132B to lens) in contact with the

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lens (126), an elongate elastic member (coil 130) encircling at least a central portion of the lens and in contact with the flexible portion of the static haptic (132B), and a dynamic haptic (132A) coupled to the elastic member (130) and configured to respond to contraction and relaxation of the ciliary muscle, thereby deforming the elastic member (130) and static haptic (132B), changing the curvature of the lens (col.4, lines 56-60).

Referring to claims 29-30, Sarfarazi discloses an IOL (fig.17B) comprising a lens (126) having an elastically deformable surface (col.4, lines 56-60; fig.3-5), an elongate elastic member (coil 130) comprising a continuous length of material greater than a circumference of the lens and having portion that overlap, the elastic member (130) coupled to the lens (126) and configured to respond to the ciliary muscle and act on the circumference of the lens to change the curvature (lens is made of a soft material is capable of changing curvature upon force, col.4, lines 56-60).

Referring to claims 31 and 35, Sarfarazi discloses an IOL (fig.17B) comprising a lens (126) having a deformable surface (col.4, lines 56-60), first (132) and second (130) members coupled to transfer force from the ciliary muscle to the lens, the second member (coil 130) comprising a strand forming a loop having a diameter that encircles at least a central portion of the lens, the first member (132) responsive to the ciliary muscle to apply a first force to the second member (130) such that a diameter of the loop changes, the second member (130) capable of applying a second force that acts on the circumference of the lens (126) to change the circumference and curvature of the lens (soft lens, and capable of deforming upon force application, see fig.3-5; col.4, lines 56-60).

Claims 28 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Skottun (US 6,117,171, cited previously). Referring to claim 28, Skottun discloses an IOL (fig.6, 7) comprising a lens (fig. 1a, 1b) having an elastically deformable curved surface (30), a static haptic (90) having a flexible portion (110) in contact with the lens, an elongate elastic member (125+135) encircling at least a central portion of the lens and in contact with the flexible portion of the static haptic (90), and a dynamic haptic (100) coupled to the elastic member (125+135) and configured to respond to contraction and relaxation of the ciliary muscle, thereby deforming the elastic member (125+135) and static haptic (90, rotates), changing the curvature of the lens (surface 30; fig. 1a, 1b).

Referring to claims 31-33, Skottun discloses an IOL (fig.6, 7) comprising a lens (fig. 1a, 1b) having a deformable surface (30), first (125+135 right hand side fig.6; one haptic) and second (125+135 left side of fig.6; other haptic) members coupled to transfer force from the ciliary muscle to the lens, the second member (125+135 left side) comprising a strand forming a loop having a diameter that encircles at least a central portion of the lens (fig.6, 7), the first member (125+135 right side) responsive to the ciliary muscle to apply a first force to the second member (125+135 left side) such that a diameter of the loop changes (from fig.6, to fig.7), the second member capable of applying a second force that acts on the circumference of the lens to change the circumference and curvature of the lens (see change of surface 30 from fig. 1A to fig. 1B). Skottun discloses a support (60 or 90 or 100) coupled to the lens supporting a fixed first curvature (10 or 20) and second changeable curvature (30).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarfarazi (US 6,423,094 B1, cited in IDS). Sarfarazi discloses a second strand member (elastic coil 130) on an IOL (fig.17B) for force transfer, however is silent to mention a material for the member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the strand member to be made of a shape memory material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Allowable Subject Matter***

Claims 1-5, 10-12, 16-19, and 36-41 are allowed.

Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



**BRUCE SNOW**  
**PRIMARY EXAMINER**